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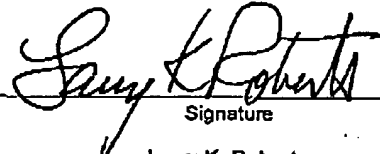
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PTO/SB/33 (07/05)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 10003568-1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number 09/870,878	Filed 5/30/2001
on _____		First Named Inventor Vance M. Stephens	
Signature _____		Art Unit 2625	Examiner Schlack, Scott A.
Typed or printed name _____			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		 Signature Larry K. Roberts Typed or printed name	
<input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)			
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 28464		(949) 250-6008 Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		December 4, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of 1 forms are submitted.			

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CENTRAL FAX CENTER****PATENT  
10003568-1****DEC 04 2006****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Vance Stephens ) Art Unit: 2625  
Serial No. 09/870,878 ) Examiner: Schlack, S.  
Filed: 05/30/2001 )  
For: TECHNIQUES FOR ALIGNING )  
IMAGES USING PAGE )  
CHARACTERISTICS AND IMAGE )  
SHIFTING )

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a request for a pre-appeal brief conference pursuant to the pilot program set out at 1296 Off. Gaz. Pat. Office 67 (July 12, 2005). A notice of appeal from the final rejection of August 4, 2006 (the "final rejection") is being filed herewith. The claims are set out at pages 2-5 of the "Response to Final Office Action" paper filed October 3, 2006.

**The Final Rejection**

Claims 1-4, 6-14 and 16-21 are pending in the application, and stand rejected under 35 USC 103 as being unpatentable over Ohsumi et al. ("Ohsumi") in view of Kato, either taken together without other applied references or variously in combination with Mizubata et al. ("Mizubata") or Wibbels et al. ("Wibbels"). These grounds for rejection have been addressed in applicant's response paper

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filed April 26<sup>th</sup>, at pages 7-12, and applicant refers to the April 26<sup>th</sup> paper for reasons as to why the rejection does not present a prima facie case of obviousness and the applied references do not teach or suggest the claimed subject matter.

It is noted that the grounds of the rejection set out in the final rejection do not take into account the amended claimed subject matter. For example, at paragraph 10, page 5 of the final rejection, third and fourth line, in discussing Claim 1, the Examiner alleges that Ohsumi discloses "... determining actual medium size and/or medium placement characteristics ...; using size and/or placement characteristics..." Claim 1 as amended recites "actual medium size and medium placement characteristics" and so the rejection does not meet the claimed subject matter.

Turning now to the Examiner's holdings set out in paragraph 4 of the final rejection, the Examiner asserts that:

...examiner Rahimi correctly asserts that Kato discloses that information relating to the length of the sheet is detected in col 5, lines 61-67 and col 6, lines 1-12. Kato discloses, "The CPU determines the timing of the stop or the reversal of the large-diameter roller 25 according to the detection signal from the sheet detection means 27a or 27b and information relating to the length of the sheet in the conveying directions input from an operation unit (not shown)." The examiner interprets this to be equivalent to determining medium size pertaining to the actual medium length of the sheet along the media feed path (seen in Fig 2 of Kato). The examiner further interprets the CPU to determine the actual length of the medium by means of the user input. For example, if the user, supplying the user input to the CPU, determines the actual length to be 11 inches (along the direction of the media feed path) in a 8.5x11 inch piece of printing paper or medium, the CPU then determines the actual length

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from the user input. Therefore, the examiner interprets the reference to correctly read on the claimed features.

The applicant respectfully submits that the foregoing discussion of Ohsumi in view of Kato clearly demonstrates why the references fail to teach or suggest the claimed subject matter. In the final rejection, the Examiner posited two alternative rationales as to how the combination allegedly describes the claimed subject matter. These are considered below.

Kato's sheet detection means 27a and 27b are used to detect the leading edge of the sheet S, and the CPU stops the large diameter roller 25 at a position before the trailing edge of the sheet reaches the duplex reversal unit UA or in duplex copying, before the trailing edge reaches the driven roller 26b. The CPU determines the stoppage of the roller 25 according to the leading edge detection signal and information relating to the length of the sheet in the conveying direction input from an operation unit. Thus, Kato clearly does not detect an actual length of the sheet in the conveying direction because he does not detect the trailing edge of the sheet after detecting the leading edge. Instead Kato relies on information "relating to the length" input from an operation unit. This inputted information can only be interpreted as a nominal length dimension, e.g., as the Examiner posits, an 11 inch length for letter size paper. Yet the actual dimension of the sheet may vary from the nominal dimension, as noted in applicant's specification, e.g. at 4:21-28. Kato does not address the problem associated with variation from the nominal dimension. Thus, the Examiner's assertion ("The examiner interprets this to be equivalent to determining medium size pertaining to the actual medium length of the sheet along the media feed path)" is without support in the applied references.

Now consider the second line of reasoning asserted by the Examiner ("The examiner further interprets the CPU to determine the actual length of the medium by means of the user input"). As pointed out above, however, at most

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the user input can only suggest entry of a nominal dimension, say 11 inches. This is not the actual length of the sheet, which may vary from the nominal dimension due to various reasons. For example, there are cutting tolerances and size variations based on moisture content (driven by relative humidity) that impact the actual size of the medium. Thus, the combination of Ohsumi and Kato does not teach or suggest the claimed subject matter, for reasons given above and in the paper filed April 26<sup>th</sup>.

Applicant further traverses the holdings set out in paragraphs 5 and 6, for reasons set out in the paper filed April 26<sup>th</sup>.

#### The Advisory Action

The advisory action states at page 2 that the "claims in question are vague and lack sufficient descriptive language as to specify what the applicant argues is lacking the said prior art combination. For example, the applicant might want to use terminology such as "calculating" and "measured" to replace the vague wording "determining" and "actual" in the claims." Applicant respectfully disagrees.

This is the first time the claims are alleged to be "vague." No rejection under Section 112 is asserted against the claims. For these reasons, applicant respectfully submits that the claims are clear and definite. To the extent that the "vague" objection refers to claim breadth, it is noted that breadth of a claim is not to be equated with indefiniteness. MPEP 2173.04.

The Examiner refers to MPEP 2111 for support that claims must be given their broadest reasonable interpretation during prosecution. Applicant does not disagree with this general rule, but even so, the interpretation must be reasonable. While the Examiner now asserts the claims are "vague," there has been no rejection of the claims on this basis, and applicant submits that the vagueness argument addresses claim breadth, not vagueness. As applicant has pointed out, the interpretation of the applied references by the Examiner is without support in the references. Moreover, if the claims, given a broad

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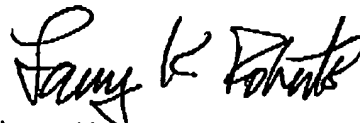
reasonable interpretation, are not met by a reference or combination of references, then applicant need not amend the claims to meet an obviousness rejection based on those references.

At pages 4-5, the Examiner adds further arguments in support of the interpretation of Kato, that the CPU determines the actual length of the medium by means of the user input. Here again, the user input is a nominal length of the medium, not the actual length. The Examiner further states: "*Further, as another example, the user is capable entering the actual length of paper, which may vary from the nominal size.*" (Italics in the original) There is no support for this conclusion in the reference. Say for example, the length is 11.1 inches; there is no mechanism described in Kato to enter such a length. What Kato suggests is entry of a nominal length dimension, say letter, legal or A4. Kato does not describe that a user would enter an actual dimension of the medium.

### CONCLUSION

Withdrawal of the outstanding rejections is respectfully requested.

Respectfully submitted,



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Registration No. 28,464

Dated: 12/4/2006

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